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| 08/982,630 | 12/02/97 | BUSH | T 1029-4012US3 |

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EXAMINER

GRANT, C

ART UNIT

PAPER NUMBER

2711

12

DATE MAILED: 11/23/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/982,630

Applicant(s)

BUSH

Examiner

Christopher Grant

Group Art Unit

2711



☒ Responsive to communication(s) filed on Sep 9, 1999

☒ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-4 and 6-55 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 10-45 and 48-50 is/are allowed.

☒ Claim(s) 1-4, 6-9, 46, 47, and 51-55 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2711

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, 6-9, 46, 47 and 51-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. (Johnson) and Hughes et al. (Hughes) (all of record).

Considering claim 1, Johnson discloses a remote control device for controlling an interactive receiver unit mainly in figures 1-7. Note the following:

- a) the claimed housing is met by the housing of the remote control (200) illustrated in figure 6;
- b) the claimed keypad is met by the keypad illustrated in figure 6;
- c) the claimed control means is met by control processor (203) of figure 7, see col. 19, lines 27-29;
- d) the claimed switch means is met by CABLE key and DMX key (see figure 6) wherein each switches between keypad selection of normal television programs (CABLE) and keypad selection of desired programming (DMX), see col. 16, line 61 - col. 17, line 11); and

Art Unit: 2711

e) the claimed transmitter means for transmitting desired programming selections is met by transmitter (205, fig. 7) which transmits programming selections to the receiver unit (100 or 300) and interacts with the receiver unit, see col. 16, line 61 - col. 20, line 55.

Although Johnson is interested in entering financial information at the remote control (200) (see buy key in figure 6 and col. 19, lines 46-53) and has a memory (203a, fig. 7) for storing data, he fails to specifically disclose a memory for storing financial information of the user and transmitting the financial information to the receiver unit as recited in the claim.

Hughes discloses a handheld terminal (10) (figs. 1-4) comprising a keyboard (14, 16, 122), a controller (110), a transmitter (146) and a memory (118) for storing financial information of the user (including but not limited to account type savings, checking) in the ordering of goods, services or video programs (col. 5, line 43 - col. 7, line 30). Note further that transmitter (146) transmits the financial information to a receiving unit (80). Hughes device facilitates the convenient placement of orders (including collection and transmission of billing/charges or financial information) of a variety of goods/services from users' terminals. Hughes handheld terminal (10) allows a user at home to make purchases with a credit card. Again, the terminal includes a memory (118) for storing financial information of the user and a slot (54-figure 2; or 132-figure 40) for wiping a card containing financial information of the user.

Therefore, it would have been obvious to one of ordinary skill in the art to modify Johnson's system to include a memory for storing financial information of the user and transmitting the financial information to the receiver unit, as taught by Hughes, for the advantage

Art Unit: 2711

of facilitating the convenient placement of orders (including financial information) of a variety of goods/services from user's terminal.

As for claim 2, the combined systems of Johnson and Hughes fail to disclose transmitting the financial information on a communication channel different from the communication channel used to transmit the programming selections as recited in the claim.

However, information transmitted from a remote control is via IR (infrared), RF (radio frequency) or wire link in a serial or parallel manner. The Examiner takes Official Notice that it is notoriously well known in the art that a single frequency (channel) is used for a serial transmission and multiple frequencies (channels) are used for a parallel transmission. The advantages of parallel transmission (communication) such as faster data rate, redundancy or the transmission of different data formats are well known in the art.

Therefore, it would have been obvious to one of ordinary skill in the art to modify the combined systems of Johnson and Hughes to include transmitting the financial information on a communication channel different from the communication channel used to transmit the programming selections for the advantage of providing parallel transmission of information which facilitates faster data rate, redundancy or transmission of different data formats.

Art Unit: 2711

Claim 6 is met by the combined systems of Johnson and Hughes, wherein Hughes discloses a slot (54-figure 2 or 132-figure 4) for wiping a card containing financial information of the user.

Claim 7 is met by the combined systems of Johnson and Hughes, wherein the slot (54, figure 2) or (132, figure 4) of Hughes is discussed above regarding claim 6.

As for claim 8, the combined systems of Johnson and Hughes fail to specifically disclose that the keypad is a QWERTY keypad as recited in the claim.

However, Hughes further discloses a well known QWERTY keypad (figure 1) for entering alpha as well as numeric characters on electronic terminals in a fast and efficient manner.

Therefore, it would have been obvious to one of ordinary skill in the art to modify the combined systems of Johnson and Hughes to include QWERTY keypad, as further taught by Hughes, for the well known advantages of entering alpha as well as numeric characters on electronic terminals in a fast and efficient manner.

Claim 9 is met by the hand held remote control device disclosed by the combined systems of Johnson and Hughes.

Art Unit: 2711

Claim 46 is met by the remote control (200) and/or receiver unit (100 or 300) providing game as one of the programming information disclosed by the combined systems of Johnson (col. 9, lines 48-61) and Hughes.

Considering claim 47, the combined systems of Johnson and Hughes fail to specifically disclose that the interactive receiver is positioned within a television set as recited in the claim. It would have been obvious to one of ordinary skill in the art to integrally position the interactive receiver within a television set, since it has been held to be within the general skill of a worker in the art to make plural parts unitary as a matter of obvious engineering choice. In re Larson, 144 USPQ 347 (CCPA 1965); In re Lockart, 90 USPQ 214 (CCPA 1951). Further, combining plural television receiving devices into a single unit makes it easier to use, saves space and offers a more commercially desirable product.

The limitations set forth in claims 51-55 correspond to the limitations discussed above in the rejection of claim 6.

3. Claims 3 and 4 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Johnson and Hughes as applied to claim 1 above, and further in view of Krisbergh (of record).

Considering claim 3, the combined systems of Johnson and Hughes disclose all the claimed subject matter above in paragraph 2, except for the device comprising the hand set of a phone,

Art Unit: 2711

dialing phone numbers from the keypad and including means for transmitting and receiving data as recited in the claim.

Krisbergh discloses a portable device (10) (figures 1-2) comprising a remote control/phone hand set (10) utilizing a keypad (24) with a switch (32) to select the device to function as a remote control or a phone. In the remote control mode, the device interacts with a cable converter box (40). The phone mode is used for dialing phone numbers and includes a transceiver (16) for transmitting and receiving data to and from the cable converter box (40). Note col. 1, lines 55 - col.2, line 2, col. 4, lines 31 - col. 6, line 38. The advantages of Krisbergh's device is that it provides an economical remote control/phone handset that share components and it facilitates the implementation of ordering cable TV services.

Therefore, it would have been obvious to one of ordinary skill in the art to modify the combined systems of Johnson and Hughes to include a hand set of a phone, dialing phone numbers from the keypad and including means for transmitting and receiving data, as taught by Krisbergh, for the advantages of providing an economically combined remote control/phone handset which additionally facilitates implementation of ordering cable TV services.

As for claim 4, the claimed switch and controller is met by switch (32) and the remote control mode of device (10) (Krisbergh) respectively, as discussed above by the combined systems of Johnson, Hughes and Krisbergh.

Art Unit: 2711

Allowable Subject Matter

4. Claims 10-45 and 48-50 are allowable over the prior art of record.

Response to Arguments

5. Applicant's arguments filed 9/9/99 have been fully considered but they are not persuasive.

Response to applicant's arguments

Applicant argues on page 4 (first paragraph) of the 9/9/99 amendment that the Johnson and Hughes references conflict in that Johnson discloses the “problems of displays” and Hughes discloses “long cables”.

In response applicant should note there is no conflict between the references. First, applicant is arguing against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Secondly, applicant is arguing about “displays” and “long cables” which are not relevant to the current issue. As a result, applicant's arguments are not persuasive.

Applicant argues on page 4 (second paragraph) of the 9/9/99 amendment that “**..Johnson is a wireless device which would mean the signal could be picked up by an external device in the same manner as a portable phone.**” and “**A factor cutting against a finding of**

Art Unit: 2711

motivation to combine or modify the prior art is when the prior art teaches away from the claimed combination”.

In response, applicant is again arguing about issues not relevant to the rejected claimed subject matter. It is true that Johnson discloses a wireless device. Wireless transmitting devices can be made secure as much as applicant's wireless system is secure. However, the rejected claims do not call for any secure transmission. Further, the references of record do not teach away from the claimed combination. Johnson discloses a home communicating **device** (as call for by the claimed) for ordering and selecting items comprising a housing, keypad, control means, switch and transmitter. Hughes discloses a home communicating **device** (as call for by the claim) for ordering and selecting items comprising a housing, keypad, control means, memory for storing financial information of the user and a transmitter. Clearly the Johnson and Hughes devices have numerous common features and functionality. It is clear that the combination of Johnson and Huges is proper and applicant's arguments are not persuasive.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

Art Unit: 2711

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Response to Amendment

7. Applicant's amendment to the specification filed 12/29/98 appears to be incorrect and/or inconsistent. Applicant should provide the appropriate page and line numbers.

Conclusion

8. **Any response to this final action should be mailed to:**

Box AF

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications; please mark "EXPEDITED
PROCEDURE")

Or:

(703) 308-5359 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Art Unit: 2711

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chris Grant whose telephone number is (703) 305-4755. The examiner can normally be reached on Monday-Friday from 8:00am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile, can be reached on (703) 305-4380.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305 3900.



Chris Grant
Primary Examiner
November 20, 1999